

REMARKS

This is in response to the Office Action dated November 02, 2006. In the Office Action the Examiner rejected Claims 1, 10, and 19 under 35 U.S.C. §112, first paragraph, based on the view that the disclosure is not enabling. Claims 1-7 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, based on the view that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Additionally, Claims 1-7 were rejected by the Examiner under 35 U.S.C. §101 based on the view that the claimed invention is directed to non-statutory subject matter.

Furthermore, the Examiner objected to the title, the drawing, and paragraphs 0020, 0022, and 0024 of the Specification.

35 U.S.C. § 112, First Paragraph:

Claim 1 was rejected under 35 U.S.C. §112, first paragraph. The Examiner concluded that there “are steps missing from the claims that are considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” (Office Action, para. 7). In particular, the Examiner proposed that claim 1 was missing a step of using “the trade trigger criteria related to the market data.” Thus, the Examiner’s argument considers the step of using “the trade trigger criteria related to the market data” as a critical or essential element of the invention and for this reason the step should be included in the claim language.

The rule regarding a disclosed critical limitation missing in the claim language provides, “An enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.” *MPEP Section 6104.08(c)*. In other words, the specification should clearly outline the criticality of the limitation for the rejection to be proper. According to this rule the Examiner’s argument for criticality may be rebutted.

The Applicant believes that the step of using “the trade trigger criteria related to the market data” is not described in the specification as a limitation that is critical for the invention to function as intended. Although the Specification discloses the use of “the trade trigger criteria related to the market data,” Applicant contends that such use is only one element out of a group of generally known elements that are uniquely combined to comprise Applicant’s invention. In other words, Applicant’s invention focuses on the unique combination of all the elements rather than any individual element such as the trade trigger criteria. Other generally known elements in Applicant’s invention may include market analysis software, on-line trading accounts and an on-line interface. Applicant’s invention provides a method for uniquely combining the known elements to automatically communicate a trade order in the marketplace without human intervention. This method is unprecedented and is confirmed as such by the Examiner’s removal of the 35 U.S.C. §102(b) and 35 U.S.C. §103(a) rejections.

Additionally, the Specification does not imply or suggest that the above step noted by the Examiner is a critical limitation. The Application broadly describes the step: “The method includes receiving trade trigger criteria and market data for use by market analysis software. The method further includes accessing the market analysis software to generate a trade decision using the trade trigger criteria and the market data.” (Brief Summary of the Invention, para. 0009; Abstract of the Disclosure). Such broad language rebuts the argument for criticality. Furthermore, paragraphs 0032, 0033, and 0038 of the Detailed Description of the Invention broadly describe the step of using “the trade trigger criteria related to the market data.” Of particular note is paragraph 0032 which is reproduced below:

“In general the market analysis software 26 allows the trader to select, set and utilize a variety trade entry and exit criteria or triggers which may be based on price, volume, or derivations thereof (referred to as technical analysis tools or indicators). Thus, such tools or indicators are based upon the various values of the market data 27. The particular combinations and/or values of such trade entry and exit criteria are referred to herein as trade trigger criteria which is received from the user 12, preferably although not required, through the user interface 22. A few examples of such trade entry and exit criteria include, but are not limited to, volume,

new highs or new lows (for periods from 1 minute to 52 weeks to current lifetime of the subject financial instrument), breakouts from corrective or consolidative patterns, support and resistance levels, trendlines, moving averages, standard deviation, volatility, rate of change, relative strength, alpha, beta, tick, arms index ("TRIN"), average directional movement, and various oscillators including, moving average convergence divergence, stochastics, relative strength index, on balance volume and accumulation/distribution. Additionally, as mentioned above, the trade trigger criteria may be based upon a status of the trading account 14. As such, account equity, trade positions, order status, and/or the prices at which the user 12 actually previously purchased or sold a given financial instrument (as opposed to previous trade decisions and orders) may be taken into account by the market analysis software 26. (Specification, para. 0032).

The broad language in the Abstract of the Disclosure, Brief Summary of the Invention and the Detailed Description of the Invention referring to the use of "the trade trigger criteria related to the market data" rebuts the Examiner's argument of criticality. Therefore, language describing such a step should not be required in the claim language because the Specification does not disclose the step as a critical limitation.

Additionally, it should be noted that while use of the "trade trigger criteria" is not a critical limitation to be included in the invention defined by Claim 1, it is clearly understood that in practice the "trade trigger criteria" would indeed be "used" by the market analysis software in order to generate a trade decision. In the context of Claim 1 for example, the market analysis software may be hosted by the online vendor that is providing the system. The communications link between the system and the market analysis software may simply take the form of an internal data flow within a software program. (Specification, para. 0037). The market analysis software directly "uses" the "trade trigger criteria" to generate a trade decision. Another "use" contemplated by Applicant's invention in the context of Claim 1 may include market analysis software maintained by a third party vendor accessible via the Internet. (Specification, para. 0036). In this example, the online vendor's system may be considered to be indirectly "using" the "trade trigger criteria" through the market analysis software of a third party vendor. Thus, Claim 1 contemplates a "use" which may occur for a

Application No.: 09/884,303
Response to Office Action of November 02, 2006
Attorney Docket: GLADS-001A

system that provides market analysis software or a system that may rely on a third party vendor for the market analysis software.

Of final note, in the Office Action the Examiner suggested a format modification for Claims 1, 10, and 19. In response, Applicant has amended Claims 1, 10, and 19 according to the Examiner's suggestion.

35 U.S.C. § 112, Second Paragraph & 35 U.S.C. 101:

In the Office Action the Examiner rejected Claims 1-7 under 35 U.S.C. §112 based on the view that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner concluded that Claim 1 overlaps two statutory classes of invention because Claim 1 begins with a method preamble but also includes the specifics of a system in the body of the Claim, namely, "through the use of a computer." The Examiner also cites "computer network," and "a personal computer" as specifics of a system in Claims 3-6. However, Claim 1 is a method claim. In performing the method it is important to describe the method in the context of hardware and software elements. Thus, the terminology used in Claim 1 "through the use of a computer," and similar wording in Claims 3-6 are used to better describe the method. Therefore, Claims 1-7 do not overlap two statutory classes of invention. Thus, there is no basis for rejection based on 35 U.S.C. §101 and 35 U.S.C. §112 second paragraph.

Examiner's Objections:

The Examiner objected to the title of the invention, the drawing, and the specification. In response to the Examiner's objections, Applicant has amended the title and specification as suggested in the Office Action. The Examiner objected to the drawing based on the view that the drawing failed to comply with 37 C.F.R. 1.84(p)(4) and 1.84(p)(5). In response to Examiner's objection, Applicant has amended the Specification so that the drawing complies with 37 C.F.R. 1.84(p)(4) and 1.84(p)(5). Therefore, all of the Examiner's objections have been addressed.

Application No.: 09/884,303
Response to Office Action of November 02, 2006
Attorney Docket: GLADS-001A

New Claim 28:

New Claim 28 recites, "using the trade trigger criteria related to the market data with the market analysis software to generate a trade decision." Claim 28 specifically addresses the "using" of the trade trigger criteria related to the market data. New dependent Claim 28 is supported by paragraphs [0032] and [0033] of the Specification and therefore does not add new matter.

Applicant believes that Claims 1, 10, and 19 are in condition for allowance. Furthermore, Applicant respectfully submits that the dependent claims 2-7, 11-18, and 20-28 are in condition for allowance for being dependent upon allowable base claims.

Should the Examiner have any suggestions for expediting allowance of the claims, she is invited to contact Applicant's representative at the telephone number listed below.

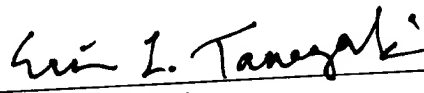
If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: 1/5/7

Customer No.: 007663

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